UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,997	03/17/2004	Constance Pauline Francis	1098.2.1	4406

36491 7590 02/24/2005

KUNZLER & ASSOCIATES
8 EAST BROADWAY
SALT LAKE CITY, UT 84111

EXAMINER	
WEINSTEIN, STEVEN L	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/802,997	FRANCIS ET AL.	
	Examiner	Art Unit	
	Steven L. Weinstein	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 USC 112, first paragraph for containing New Matter. Claims 1, 12, and 17 now recite that the filler has substantially neutral aromatic and gustatory properties and the substantially solid filler has been pulverized to form a dissolvable powder. Both of these concepts, that is, the entire phrasing, appears to be New Matter not supported by the specification as originally filed. The specification is silent as to substantially neutral aromatic and gustatory properties as well as pulverizing. Also, the specification discloses that sugar can be a filler which certainly has a gustatory (of or pertaining to taste) effect. Even a filler, which is a nondairy creamer by definition, would have an affect on taste since it is a substitute for a dairy creamer which alters or affects the taste of the product it is to be added to. Not only do the claims contain New Matter, but they are also non-enabling as to the phrase "substantially neutral aromatic and gustatory properties" since the limits of substantially are not defined and the fillers can have sweeteners and creamers.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 9, 10, 12, 13, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maddox (3,620,759) in view of Scott (1,393,045) and Limur (4,076,848).

In regard to claim 1, Maddox discloses a dissolvable flavoring capsule comprising a capsule and a selected amount of a dissolvable flavoring mixture disposed within the capsule, the dissolvable favoring mixture comprising a favoring additive and a filler that is also a dissolvable powder. See, for example, in this regard, column 3 of Maddox wherein Maddox discloses that the capsule can include dehydrated coffee, tea, cream, milk, chocolate, cocoa, soup, sweeteners, essences, fillers, flavorings and the like and mixture of the same where appropriate. Also, Maddox discloses that the food can be in the form of a powder, crystal, pellet and granule. Claim 1 now recites that the filler has "substantially" neutral aromatic and gustatory (i.e. pertaining to taste) properties and is pulverized. How the product has become a powder is not seen to be limiting in a product claim. As to the "substantially neutral" limitation, whether one chooses to have fillers which add to or modify the overall taste sensation of the flavoring capsule is seen to have been an obvious matter of choice. Applicants do not appear to be the inventors of any of the compositions. In fact, as disclosed, applicants teach employing conventional compositions. Applicants appear to have urged in the specification that they were the first to put flavoring in capsules for mixing with foods (which, as disclosed, could be water) to impart the flavoring to the foods. Contrary to what has been urged, applicants were not the first to employ flavoring capsules. The art is replete with such examples. Maddox ever points out the advantages of such capsules which are also

applicants' disclosed advantages (e.g. less loss of material, less mess and the use of measured portions). Scott and Limur can be relied on as further evidence of flavoring capsules that contain flavoring additives (e.g. coffee, spices, etc); with/without additional additives such as sweeteners such as sugar and milk, etc. Note that Scott discloses that the flavoring capsule containing coffee extract can be added to a food such as milk to flavor the milk and Limur intends the flavoring capsules to flavor meats, soups, stews, sauces, water, etc. Note that Limur emphasizes that substances such as tea is a flavoring.

Claims 3-8, 11, 14, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Hutchison et al (5,871,798) and Sanker (5,620,707) for the reasons given in the Office action mailed 9/3/04.

Note that Maddox teaches color coding the gelatin capsule. The combination of Hutchison et al and Sanker teach it would have been obvious to modify Maddox and flavor the capsule, provide compatible and/or same favoring and/or coloring, etc.

All of applicant's remarks filed 12/6/04 have been fully and carefully considered but are not found to be convincing.

Applicants remarks are considered to be moot in view of the new ground of rejection necessitated by the amendment. The newly adding phrasings that applicants emphasize in the remarks are seen to be New Matter as discussed above. In any case, as also discussed above, whether any additional components of the capsule impart any effect on the overall taste of the food product or not is seen to have been an obvious

matter of choice. The urging relative to Scott is unclear and is based on limitations not found in the claims. Claim 1 recites a dissolvable favoring capsule which has a flavoring additive. Coffee flavor is certainly a flavoring additive and it is being added in Scott to flavor milk which is a food. What one chooses to add any flavoring capsule to is an obvious matter of intended use. Also, although Sanker is no longer being relied on under 35 USC 102, Sanker would not have to teach solids since the art taken as a whole teaches capsules containing powdered flavoring agents. Note, too, Maddox discloses it was notorious conventional to provide food additive capsules wherein the capsules are intended to be added to foods including aqueous liquids and that these capsules can include essences, or flavorings, or tea, or cocoa, or even mixtures. A tea capsule is just as much a flavoring capsule as is an essence or flavoring capsule in that it provides the food product it is dissolved in with a tea flavor. Applicants appear to be attempting to make this distinction; that is, a tea capsule is not a flavoring capsule. This is not convincing for the reason given above nor do claim such as claim 1 make this distinction. In any case, Maddox, in disclosing that the contents of the capsules can include essences and flavorings, makes this urging moot. Thus, applicants are clearly not the inventors of flavoring capsules. Note, too that if one desired to provide a lemon flavoring capsule, one would not obviously add an additive to the capsule which would overcome the lemon flavor and defeat its purpose.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP§706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven L Weinstein whose telephone number is (571) 272-1410. The examiner can normally be reached on Monday-Friday 7:00am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven Weinstein
STEVE WEINSTEIN
PRIMARY EXAMINER 1761